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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,781	03/09/2004	Thomas E. Tamburrini	51306/401:1	4145

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EXAMINER	
LE, THIEN MINH	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/797,781	TAMBURRINI ET AL.	
	Examiner	Art Unit	
	Thien M. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *18-25* is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The preliminary amendment filed on 3/9/2004 has been entered. Claims 1-25 are presented for examination.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1- 12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,575,368 (herein referred as "the '368 patent"). This is a double patenting rejection.

Claims 1-12 are rejected in view of claims 1-12 of the '368 patent in that the claims recite as follow:

1. A data reading device comprising a housing; a first window disposed on a first side of the housing; a second window disposed on a second side of the housing; a beam scanning mechanism within the housing; a light source producing at least one reading beam directed onto the beam scanning mechanism; first generating optics for generating a first scan pattern passing through the first window; second generating optics for generating a second scan pattern passing through the second window, wherein the first scan pattern is optimized for fixed mode scanning and the second scan pattern is optimized for portable mode scanning.

2. A data reading device according to claim 1 wherein the beam scanning

mechanism comprises a rotating mirror facet wheel.

3. A data reading device according to claim 1 wherein the second scan pattern comprises a single scan line and the first scan pattern comprises a relatively complex multiple line scan pattern.

4. A data reading device according to claim 1 wherein the first scan pattern optimized for fixed mode is operable for both sweep and presentation modes of scanning.

5. A data reading device according to claim 1 further comprising a switch for switching the data reading device between a first mode generating the first scan pattern and a second mode generating the second scan pattern.

6. A data reading device according to claim 5 wherein the switch comprises a manually-actuated switch.

7. A data reading device according to claim 5 wherein the switch comprises a sensor which detects grasping of the device.

8. A data reading device according to claim 5 wherein in the handheld mode of operation, the data reading device is enabled to read objects with the second scan pattern.

9. A data reading device according to claim 1 further comprising means for switching the data reading device between a first mode of operation wherein the data reading device is enabled to read using both the first and second scan patterns and a second mode of operation wherein the data reading device is enabled to read using only one of the first and second scan patterns.

10. A data reading device according to claim 1 further comprising a motion sensor which, upon sensing motion of the device, switches the data reading device to a handheld mode of operation.

11. A data reading device according to claim 1 wherein the rotating facet wheel includes at least one corner cube containing two facets disposed perpendicularly for generating an aiming beam.

12. A data reading device according to claim 2 further comprising electronics for turning off the light source whenever the reading beam would strike a selected portion of the facet wheel.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,575,368 (herein after referred as "the '368 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recited essentially the same limitations.

Claims 13-17 is rejected in view of claims 14-25 of the '368 patent. Specifically, claims 14-24 of the '368 patent recite the following limitations:

14. A method for data reading comprising the steps of providing a housing having at least one opening; providing a rotating facet wheel within the housing; generating a reading beam and directing the reading beam onto the facet wheel; reflecting the reading beam off facets of the facet wheel to scan the reading beam across a plurality of pattern mirrors for producing a first scan pattern for a first mode of operation and a second scan pattern for a second mode of operation; detecting return signals from both the first and second scan patterns being reflected off an item being read and sending the return signals to a decoder; wherein in the first mode of operation, selectively decoding only return signal from the first scan pattern and wherein in the second mode of operation, selectively decoding only return signals from the second scan pattern.

15. A method for data reading according to claim 14 further comprising

selectively switching between operating solely in the first mode of operation and operating solely in the second mode of operation.

16. A method for data reading comprising the steps of providing a housing having at least one opening; providing a rotating facet wheel within the housing; generating a reading beam and directing the reading beam onto the facet wheel; reflecting the reading beam off facets of the facet wheel to scan the reading beam across a plurality of pattern mirrors for producing a first scan pattern for a first mode of operation and a second scan pattern for a second mode of operation; optimizing the first scan pattern and mode of operation for a first type of scanning; optimizing the second scan pattern and mode of operation for a second type of scanning; switching between the first and second modes of operation, the first mode of operation comprising a fixed mode and the second mode of operation comprising a handheld mode; optimizing the first scan pattern produced during the fixed mode of operation by generating a complex scan pattern for reading symbols passed in various orientations in a scan volume; and optimizing the second scan pattern produced during the handheld mode of operation by generating a generally single line scan pattern to be aimed onto a symbol.

17. A method for data reading according to claim 14 further comprising disabling the second mode while operating in the first mode.

18. A method for data reading comprising the steps of providing a housing having at least one opening; providing a rotating facet wheel within the housing; generating a reading beam and directing the reading beam onto the facet wheel; reflecting the reading beam off facets of the facet wheel- to scan the reading beam across a plurality of pattern mirrors for producing a first scan pattern for a first mode of operation and a second scan pattern for a second mode of operation; optimizing the first scan pattern and mode of operation for a first type of scanning; optimizing the second scan pattern and mode of operation for a second type of scanning; providing the housing with first and second openings; directing the first scan pattern out the first opening; directing the second scan pattern out the second opening.

19. A method for controlling a data reading system, the data reading system including a housing, comprising the steps of providing the housing with a first opening and a second opening; generating a first scan pattern optimized for a fixed mode of scanning through the first opening; generating a second scan pattern optimized for a handheld mode of scanning through the second opening.

20. A method for controlling a data reading system, the data reading system including a housing, comprising the steps of generating a first scan pattern optimized for a first mode of scanning; generating a second scan pattern

optimized for a second mode of scanning; detecting return signals from both the first-and second scan patterns being reflected off an item being read; operating in the first mode of scanning by selectively decoding only scan lines of the first scan pattern.

21. A method according to claim 20 further comprising selecting the desired mode of operation via manual actuation of a switch.

22. A method according to claim 20 further comprising sensing a given operational parameter and automatically selecting the desired mode of operation based upon the parameter.

23. A method according to claim 20 further comprising operating in the second mode of scanning by decoding only scan lines of the second scan pattern and not the scan lines of the first scan pattern.

24. A method according to claim 23, wherein the first scanning mode comprises portable operation and the first scan pattern comprises a single scan line and the second scanning mode comprises fixed operation and the second scan pattern comprises a complex scan pattern of a multiplicity of scan lines.

25. A method according to claim 20 further comprising switching from the first mode to the second mode by controlling a signal processor to decode only scan lines of the second scan pattern and not the scan lines of the first scan pattern.

As can be seen, from the above, the method claims of the '368 patent recite all limitations set forth in the method claims of the instant application. Thus, the patent protections for these method claims have been granted in earlier filed and patented application.

Allowable Subject Matter

Claims 18-25 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose an optical scanner comprising a first and a second scanning windows, a rotating facet wheel comprising a plurality of primary mirror facets and having the functions and characteristics as recited in claim 18.

The prior art also fails to disclose the limitations of claims 22 and 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Le, Thien Minh
Primary Examiner
Art Unit 2876
July 22, 2004